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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,469	09/26/2003	Thomas Friedrich Bunemann	090128-0306137	7396

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EXAMINER	
TOOMER, CEPHIA D	
ART UNIT	PAPER NUMBER
1714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/670,469	BUNEMANN ET AL.	
	Examiner	Art Unit	
	Cephia D. Toomer	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *6/27/06;10/19/06*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *20-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *20-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the amendment filed June 27, 2006 in which claims 20 and 21 were amended and the remarks filed October 19, 2006.

The rejection of the claims under 35 USC 112, second paragraph is withdrawn in view of the amendment to the claims.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 20-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,693,064. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions of the present invention are suitable for use in a

hydraulic fluid and the compositions of the patent are hydraulic fluids containing the present compositions.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 20-25, 27 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honig (US 4,234,497).

Honig teaches a polyol ester useful as a basestock lubricant comprising one or more polyhydric alcohol, isopalmitic acid and one or more C_5-C_{11} carboxylic acid (see abstract). It should be noted that Applicant's intended use is given no patentable weight given that the claims are directed to a composition per se. The polyhydric alcohol may be neopentyl glycol, pentaerythritol, trimethylolpropane, dipentaerythritol, etc. (see col. 2, lines 47-64). The ratio of isopalmitic acid to monocarboxylic acid is from about 0.05:1 to about 1:1 (see col. 3, lines 19-22). Honig teaches that lubricants are prepared such that 90 wt% of the polyol ester is present and that the lubricants contain an additive package comprising an anti-wear agent and antioxidant (see col. 3, lines 61-68; col. 4, lines 1-4).

Honig teaches the limitations of the claims other than that the composition has a viscosity of 7000 mm^2/s or less when measured at –30 °C after being held at –30 °C for

168 hours. However, no unobviousness is seen in this difference because Honig teaches polyol esters that are within the scope of the present invention and it would be reasonable to expect that the polyol ester compositions of Honig would possess similar if not the same viscosity when measured at –30 °C after being held at –30 °C for 168 hours.

5. Claims 20-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 612 831.

EP teaches a hydraulic fluid comprising a synthetic ester formed by reacting trimethylolpropane with a carboxylic acid comprising 15-85 mol% oleic acid/isostearic acid and 85 mol% or less of a C_6-C_{22} carboxylic acid, excluding oleic and isostearic (see abstract; page 1, lines 48-54; page 2, lines 15-29). The hydraulic fluid contains a high molecular weight compound such as a polymethacrylate (functions as a viscosity index improver)(see page 4, lines 10-16). The fluid also contains additives such as antioxidants, extreme pressure agents (anti-wear agents) and defoaming agents (see page 4, lines 27-40). EP teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, EP differs from the claims in that it does not specifically teach the claimed proportions. However, EP teaches that 85-15 mol% of oleic/isostearic acid is combined with 85 mol% or less of the C_6-C_{22} acid. Given these proportions, it would have been obvious to one of ordinary skill in the art to optimize these proportions to obtain through routine experimentation for best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when

the optimization is obtained through routine experimentation unless there is a showing of unexpected results that properly rebuts the *prima facie* case of obviousness. See *In re Boesch,* 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Furthermore, given that EP teaches that the fluid of his invention is a hydraulic fluid, it would be reasonable to expect that the hydraulic fluid of EP would possess similar if not the same viscosity when measured at –30 °C after being held at –30 °C for 168 hours.

6. Claims 20-24, 26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mancini (US 4,025,447).

Mancini teaches esters as components of lubricants wherein the esters are prepared by reacting a mixture of polyol, including trimethylolpropane and a mixture of linear alkyl monocarboxylic acids comprised of (1) one or more acids having from 7 to 8 carbon atoms and (ii) one or more acids having from 12 to 18 carbon atoms. The ratio of acids (i) to (ii) being from about 1.5:1 to 6:1 (see abstract; claim 3). Mancini teaches that the composition contains viscosity index improvers (see col. 5, lines 40-45).

Mancini teaches the limitations of the claims other than that the composition has a viscosity of 700 mm^2/s or less when measured at –30 °C after being held at –30 °C for 168 hours. However, no unobviousness is seen in this difference because Mancini teaches polyol esters that are within the scope of the present invention and it would be reasonable to expect that the polyol ester compositions of Mancini would possess

similar if not the same viscosity when measured at –30 °C after being held at –30 °C for 168 hours.

7. Applicant's arguments have been fully considered but they are not persuasive.

8. Applicant argues that Honig teaches isopalmitic acid in combination with short chain fatty acids. Applicant argues that the branched chain acid does not suggest the claimed straight chain fatty acids having from 16 to 22 carbon atoms.

In determining obviousness of a composition, it is appropriate to consider, *inter alia,* (1) the manner of its preparation vis-a-vis the prior art, (2) the structural similarities as well as differences between the claimed composition and that of the prior art, and (3) the presence or absence of properties in the composition which would be unobvious in view of the prior art. In re Burt, 148 USPQ 548 (CCPA 1966). It should not de determined on the basis of structure alone. In re Lunsford, 148 USPQ 718 (CCPA 1966); In re Lewis, 172 USPQ 238 (CCPA 1972). In the instant case, there is nothing on record that would indicate that the polyol ester of Honig would not perform the same function as that of the claimed polyol ester.

9. Applicant argues that EP '831 requires the presence of at least 15 mol% isostearic acid and therefore does not suggest a mixture of fatty acids consisting essentially of the claimed fatty acids.

The terms "consisting essentially of" do not mean "consisting solely of". The phrase "consisting essentially of" excludes ingredients that would affect the basic and novel characteristics of the product defined in the claims. The addition of 15 mol% of isostearic acid would not do this.

10. Applicant argues that each of the examples of Mancini includes a weight ratio that is less than 1:1 by weight.

It is well settled that a reference is relied upon for all that it teaches and is not limited to the examples contained therein. Mancini renders obvious the claimed composition because he teaches alcohols, fatty acids and fatty acid ratios that are within the claimed range.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cephia D. Toomer
Primary Examiner
Art Unit 1714

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